

### REMARKS

This is in full and timely response to the above-identified Office Action. The above listing of the claims replaces all prior versions, and listings, of claims in the application. Reexamination and reconsideration in light of the proposed amendments and the following remarks are respectfully requested.

### Claim Status

Originally filed claims 1-22 have been amended to clarify the claimed subject matter over that disclosed in the art cited in this Office Action. Two new dependent claims 23 and 24 have been added. Both these claims depend from claim 10 and find support in the specification - see paragraphs [0033] and [0037] for example. The subject matter of these claims is patentable over the art of record for at least the reasons set forth below.

### Double Patenting

It is respectfully submitted that the Applicant is willing to consider the filing of a terminal disclaimer, however, wishes to wait until either this application or one of the below listed copending applications issues, thus establishing which applications will be terminally disclosed with respect to which. In the interim, the double patenting rejection is provisionally traversed for at least the reason that it is not yet determined what the exact scope of the claims of each application will be at the time of their respective allowance. The double patenting rejection is also traversed in that the claims of this and the other three applications have been amended in a manner which is deemed to overcome the rejection.

- 1) 10012443-1 (084061-0165) 09/925,649 Advisory - Examiner Wallerson
- 2) 10012446-1 (084061-0166) 09/925,650 final rejection - Examiner Wallerson
- 3) 10012445-1 (084061-0167) 09/925,651 first action - Examiner Singh

IDS

An IDS which lists the above disclosed applications along with the art cited therein, is submitted with this response.

Rejection under 35 USC § 101

Claim 22 has been revised to include a recitation of a computer readable medium. This amendment is submitted to overcome the rejection.

Rejections under 35 U.S.C. § 102

The rejection of claims 1-8, 15-18 and 21-22 under 35 U.S.C. § 102(a) as being anticipated by Marx (USP 6,348,970) is respectfully traversed.

It is submitted that the claims as amended in this response define subject matter which is neither disclosed nor suggested by this reference. Indeed, the rejection under § 103 make it clear that the subject matter now recited in the independent claims is not anticipated.

Rejections under 35 U.S.C. § 103

The rejection of claims 9-14 and 19-20 under 35 U.S.C. § 103(a) as being unpatentable over Marx in view of Wolf (USP 6,348,970) is respectfully traversed.

In this rejection, it is admitted that Marx does not disclose printing one document within another nor identifying the contents of the documents. To overcome this shortcoming Wolff is cited. However, the cited sections of Wolff do not disclose anything that might lead the hypothetical person of ordinary skill in the direction of claimed subject matter.

That is to say, in order to establish a *prima facie* case of obviousness, it is necessary to show that the hypothetical person of ordinary skill would, without any knowledge of the claimed subject matter and without any inventive activity, be motivated to arrive at the claimed subject matter given the guidance of the cited references when each is fully considered as statutorily required.

Column 6, lines 23-57 of Wolff discloses:

Where the document comprises, for instance, a form, gateway 102 may be required to perform recognition on specific areas or boxes on the image to identify the documents to be retrieved. Gateway 102 may also have to locate marks (e.g., "x," etc.) placed on the document by the user that are part of the document selection process.

Using the locator/identifier, gateway 102 **retrieves the desired documents** over the Internet 105 (processing block 403). In one embodiment, gateway 102 locates and retrieves the document(s) using URLs extracted from the fax received from the user. Note that gateway 102 may also have to use marks (e.g., "x") on the image along with the locator/identifier to retrieve a document. In such a case, a different document is sent if the mark is made in a different location, even though the locator/identifier is the same.

**Once the desired documents have been obtained**, gateway 102 **creates an image of each document** for transmission to the user (processing block 404). In one embodiment, gateway 102 creates images by parsing, formatting and rendering the documents. The parsing of the documents, as well as formatting and rendering of the parsed documents, includes the conversion of document identifiers/locators associated with the retrieved documents to a machine readable code (e.g., bar code, digital paper, etc.) to be included in the images faxed to the user (to enable user selection of additional documents). Rendering is necessary for most documents to convert the data from ASCII to a raster bitmap, the protocol used by fax machines (and other marking engines).

Once the image has been created, gateway 102 sends the image by fax to the user (processing block 405). Upon receipt of the retrieved documents from gateway 102, the user may select

additional documents for retrieval as described above. In this manner, a fax machine may retrieve any document on the Web without having an Internet connection available to itself.  
(Emphasis added)

It is submitted that the above quotation contains nothing that might suggest that one document could be printed within another, and inasmuch as this includes the sections of the Wolff reference which are relied upon to support the rejection, it is submitted that, for at least this reason, a *prima facie* case of obviousness has not been established.

The rejection also lacks proper motivation to consider a transfer of teachings. What is proffered is that the alleged teachings of Wolf would be transferred to Marx to "allow greater user control of the formatting of retrieved documents."

It is submitted that improved formatting, even if (*arguendo*) considered necessary in the Marx arrangement, would motivate any consideration of merging one document with another in the manner as now claimed.

#### Conclusion

It is submitted that the claims as they stand before the PTO are allowable for at least the reasons advanced above. Favorable reconsideration and allowance of this application is courteously solicited.

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